

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD G. RUSSELL

Appeal No. 2003-0436
Application 09/372,835

ON BRIEF

MAILED

SEP 05 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WARREN, LIEBERMAN and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.196(a) (2003); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 1, Feb 2003; 1200-29 – 1200-30).

In response to appellant's arguments directed to DeSena in the brief (pages 12-14), the examiner discusses the disclosure of this reference in the answer (pages 3-7) more expansively than in the final rejection of August 29, 2001 (Paper No. 18; pages 3 and 4-5) or any other action, including applying the disclosure of DeSena to specific claim limitations and the development of new issues, relying on specific section of the reference not previously cited.

Appellant responds to the examiner's treatment of DeSena in the answer in one section of the reply brief (pages 7-9) and presents additional argument with respect to this reference in the

other parts of the reply brief, including the section that focuses on the evidence alleged to establish commercial success in which specific claim limitations are discussed (pages 2-6 and 9-12).


Thus, appellant's substantial new arguments in the reply brief are aimed at the basic factual underpinning of the examiner's ground of rejection as expanded in the answer to which the examiner has not responded. To the extent that a *prima facie* case of obviousness had been made out by the examiner over DeSena as applied in the answer, appellant's new factual arguments in rebuttal in the entered reply brief shifted the burden back to the examiner to again establish the factual underpinning of a *prima facie* case under 35 U.S.C. § 103(a) on the record as a whole in order to maintain the ground of rejection. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

Accordingly, under the provisions of 37 CFR § 1.193(b)(1) (2003), we hereby remand this application to the examiner to prepare a supplemental examiner's answer responding to the arguments presented by appellant in the reply brief, or to take any other appropriate action consistent with current examining practice and procedure, with a view toward placing this application in condition for decision on appeal with respect to the issues presented. We note here that § 1.193(b)(1) provides that appellant may file a reply brief to the supplemental examiner's answer.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 1, Feb 2003; 700-121). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP§ 1211 (8th ed., Rev. 1, Feb 2003; 1200-30).

Remanded


CHARLES F. WARREN

~~CHARLES F. WARREN~~
Administrative Patent Judge


PAUL LIEBERMAN

PAUL LIEBERMAN
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
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Catherine Lee

CATHERINE TIMM
Administrative Patent Judge

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